



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,038	03/05/2002	Teemu Puskala	P2857US00	8149
36671 7590 12/15/2009 DITTHAVONG MORI & STEINER, P.C. 918 Prince Street Alexandria, VA 22314				
EXAMINER PIERCE, DAMON JOSEPH				
ART UNIT 3714		PAPER NUMBER		
NOTIFICATION DATE 12/15/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

Office Action Summary

Application No.

10/091,038

Applicant(s)

PUSKALA, TEEMU

Examiner

DAMON PIERCE

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-12, 15,24,25,30,54 and 56-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9-12, 15,24,25,30,54 and 56-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-944)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/23/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The examiner acknowledges the amendments of claims filed on 11/10/09. Currently, claims 2-8, 14, 17-23, 26-29, 31-53 and 53 have been cancelled, and new claims 56-64 have been added. Thus, claims 1, 9-12, 15, 24-25, 30, 54, and 56-64 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/09 has been entered.

Claim Objections

3. Claims 9, 24, 25, 61, 62, and 63 are objected to because of the following informalities: all above mentioned claims are dependent on claims that have been cancelled, thus are improper. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 9-12, 15, 24-25, 30, 54, and 56-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically claims 1, 16, 54, and 64, all include the recitation “the event-related predefined message being generated independently of the gaming content” and “the event-related predefined message also being automatically modified to be transmitted from the service platform as requested by the at least one terminal”, (emphasis added) which lacks antecedent basis in the original specification, thus is new matter. In addition, claim 64, includes the recitation “computer-readable medium storage medium”, which lacks antecedent basis in the original specification, thus is new matter.

Also, dependent claims 58-63, include the following recitations not supported by the original specification, and are thus new matter.

- claim 58, recites “wherein said service platform automatically attaches a web link of the on-line gaming service to the at least one event-related predefined message, prior to sending out the at least one event-related predefined message therefrom”, (emphasis added);
- claims 59, 61, and 62, recites “wherein said service platform receives from the at least one terminal an event-related predefined message

attached with an issue that is encountered when consuming the interactive content and needs to be addressed, sends an automated response to the issue to the at least one terminal, and charges a user of the at least one terminal for the response", (emphasis added);

- claim 60 and 63, recites "wherein said service platform prompts the user to send the event-related predefined message attached with the issue or causes the event-related predefined message attached with the issue to be sent".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 9-12, 15, 24-25, 30, 54, and 56-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically claims 1, 16, 54, and 64, all include the recitations "the event-related predefined message being generated independently of the gaming content by automatically identifying an event that occurs during the on-line gaming service", (emphasis added) are unclear what is meant by these recitations because according to the original specification pg. 14, 3-9, event-related predefined messages are sent (generated) based on an event occurring during the game, which seems inconsistent with claim language, yet, according to original specification, pps. 28-29, general "predefined messages" not specific "event-related predefined messages" are sent

Art Unit: 3714

(generated) based on a particular on-line service. For purposes of examination, as best understood, the above claim recitation is interpreted as the "event-related predefined messages" are sent and received in response to the gaming content; however, the "event-related predefined messages" are generated or made separately from the gaming content.

Dependent claims 58-63 include the recitations that not supported by the original specification, and are deemed indefinite because the examiner does not completely understand the inclusion of the scope or metes and bound of the claimed invention as currently presented.

Also, claims 9, 24, 25, 61, 62, and 63 are indefinite because claims are dependent on claims that have been cancelled, and examiner does not know which claims the above mentioned claims are to depend on. As best understood all the above mentioned claims depend on independent claim 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3714

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1, 11-12, 15-16, 24, 30, 54, 56-57, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. # 6,716,103 to Eck et al (Eck).

Regarding claims 1, 11, 15, 16, 30, 54, 56, 57, 64, Eck discloses **a system** (see Fig. 4) comprising:

a service platform configured to run an on-line gaming service for providing a gaming content (col. 10, 1-15, discloses game play via online connection), by:

providing for transmission of the gaming content to at least one terminal via a network (abstract, Figs. 3-4, and col. 5, 44-67 to col. 6, 1-32, discloses transmission of game program to a portable game machine); and

providing along with the transmitted gaming content of at least one event-related predefined message to the at least one terminal (abstract, discloses the pager cartridge connected to a game machine receives messages containing video game program instructions, where lacking distinguishing features, the messages disclosed are interpreted as event-related predefined messages), and **the event-related predefined message also being automatically modified to be transmitted from the service platform as requested by the at least one terminal to at least another one terminal based upon a presenting capability of the at least another**

one terminal (col. 25, 41-67 to col. 26, 1-22, discloses the use emulation to achieve information compatibility of varying devices, note: in a case, where devices are the same, the predefined messages are automatically modified to enable similar terminals to receive messages); and

the at least one terminal (Fig. 3, 10, and Fig. 4, 105) configured to:

receive the gaming content and the at least one event-related predefined message from said service platform through the network (abstract, Figs. 3-4, and col. 5, 44-67 to col. 6, 1-32, discloses transmission of game program to a portable game machine),

the at least one terminal (Fig. 3, 10, and Fig. 4, 105),

enable selecting, by a user of said at least one terminal, whether to transmit one or more of the provided at least one event-related predefined message from said at least one terminal (col. 9, 10-59, discloses a variety of messages that a user can choose to send to another game terminal); and

when the user of said at least one terminal selects to transmit one or more of the provided at least one event-related predefined message, transmit the selected one or more of the provided at least one event-related predefined message to at least one address selectable by the user of said at least one terminal (col. 9, 10-59 and Fig. 8G, discloses a variety of messages that a user is capable of choosing to send to another game terminal via an "address book"). However, Eck fails to explicitly disclose the event-related predefined message being generated

independently of the gaming content by automatically identifying an event that occurs during the on-line gaming service.

Yet, Eck does disclose a plurality of event-related predefined messages that are generated independently of the game yet are automatically identified by an event, (col. 20, 6-67 to col. 21, 1-67), for example, the phrase, "game over" is created outside of the gaming content, yet, at the same time the phrase, "game over" is also sent to gaming terminals once an event has occurred to cause a game to end. Thus, the gaming system of Eck would have motivation to use independently generated event-related predefined messages in order to expand the range of information presented to game players during the course of the game in order to improve the enjoyment of the game.

12, 24, Eck discloses the system of claim 1, wherein the at least one event-related predefined message comprises an automated message that is sent automatically to the at least one address selectable by the user of the at least one terminal when at least one condition of the gaming content matches any of a predefined criteria (col. 14, 47-67 to col. 15, 1-47, discloses automatically providing messages to game terminals during game play).

59, 60, 61, 62, 63, Eck discloses the system of claim 1, wherein said service platform receives from the at least one terminal an event-related predefined message attached with an issue that is encountered when consuming the interactive content and needs to be addressed, sends an automated response to the issue to the at least one terminal, and charges a user of the at

least one terminal for the response (col. 15, 48-65, discloses "auto-messaging", in this case, the issue is the message, i.e., the message that a kill has taken place is the issue, or a player sending an invitation message being the issue, where the user is charged a per usage fee for sending messages as disclosed in col. 16, 49-63).

10. Claims 9-10, 25, and are 58 rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. # 6,716,103 to Eck et al (Eck) in view of US Pub. 2002/0112014 to Bennett al (Bennett).

Regarding claims 9, 10, 25, Eck discloses both terminals may be mobile except phones. Bennett discloses mobile phones (see Fig. 1) including a dedicated button to be activated by the user of the at least one terminal to cause one or more of the provided at least one event-related predefined message to be transmitted to the at least one address selectable by the user of the at least one terminal (parg. 114). It noted that the gaming terminal of Eck has similar capabilities as such as those of the mobile phone of Bennett and these devices are interchangeable.

Therefore, it would have been obvious to a person of ordinary skill in the art to substitute the gaming device of Eck with the mobile phone of Bennett in order to accomplish game play with a more commonly own device, thus, motivating and attracting more game players that currently own a mobile phone to play games.

58, Bennett discloses the system, wherein said service platform automatically attaches a web link of the on-line gaming service to the at least one event-related

predefined message, prior to sending out the at least one event-related predefined message therefrom (parg. 164, discloses a URL or a web link, where it is well known in the art that messages sent over the Internet via a computing device such as a cellular phone may contain a browser link such as a URL or corresponding link in order to provide a user with quick and easy access to a web site).

11. Claims 9-11, 25-26, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. # 6,716,103 to Eck et al (Eck) in view of US Pat. #6,983,310 to Rouse et al (Rouse).

Regarding claims 9, 10, 11, 25, 26, Eck discloses both terminals may be mobile except phones. Rouse discloses mobile phones (col. 1, lines 16-21); wherein the at least one wireless terminal comprises a dedicated button to cause the content-related predefined message to be transmitted to the selected address, the "Send" button on any cellular phone acts as a dedicated button to begin a transmission; and an indicator to be displayed to indicate that at least one content-related predefined message is available for selection (col. 8, lines 5-8). Specifically, Rouse discloses selecting means for enabling selecting whether to originally transmit one or more messages from the wireless terminal in col. 9, lines 43-46. That is, phone keys provide the wireless device user with the ability to select a forward option **718**, which enables a user to forward a selected message to a recipient (col. 9, lines 14-35).

Additionally, Rouse discloses transmitting means for wirelessly transmitting at least one message (col. 5, lines 45-48; col. 10, lines 3-24) to at least one address

Art Unit: 3714

selectable by the user of said at least one wireless terminal (col. 9, lines 47-55). The ability to forward messages among cell phone users, e.g. "text messaging", is well known to one of ordinary skill in the art. To implement such a feature in a system such as the one taught by Eck, which contemplates wireless communication capabilities between portable devices, would have required only routine skill in the art.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Eck and Rouse as Eck discloses the ability to communicate with external devices via a phone link, as discussed above. All of the claimed elements were known, i.e. providing content and event-related predefined messages to a user of a wireless device and the ability to forward messages among users of wireless devices including cellular phones, at the time of the invention and could have been combined by one of ordinary skill in the art in order to produce predictable results.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the gaming system of Eck with the user interface configuration of Rouse in order to provide a more user-friendly system, which would attract more users to this system.

58, Rouse discloses the system, wherein said service platform automatically attaches a web link of the on-line gaming service to the at least one event-related predefined message, prior to sending out the at least one event-related predefined message therefrom (col. 17, 1-6, discloses a URL to any web page, where it is well known in the art that messages sent over the Internet via a computing device such as a

Art Unit: 3714

cellular phone may contain a browser link such as a URL or corresponding link in order to provide a user with quick and easy access to a web site).

Response to Arguments

12. Applicant's arguments with respect to claims 1, 9-12, 15, 24-25, 30, 54, and 56-64 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAMON PIERCE whose telephone number is (571)270-1997. The examiner can normally be reached on 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry. Suhol/
Supervisory Patent Examiner, Art
Unit 3714

DJP